

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SYNGENTA SEEDS, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civ. No. 02-1331-SLR
	)	
MONSANTO COMPANY, DEKALB	)	
GENETICS CORP., PIONEER HI-	)	
BRED INTERNATIONAL, INC.,	)	
DOW AGROSCIENCES, LLC, and	)	
MYCOGEN PLANT SCIENCE, INC.	)	
and AGRIGENETICS, INC.,	)	
collectively d.b.a. MYCOGEN	)	
SEEDS,	)	
	)	
Defendants.	)	

**MEMORANDUM ORDER**

At Wilmington this 19<sup>th</sup> day of November 2004, having reviewed defendants' consolidated motion for summary judgment that asserted claims of the patents-in-suit are invalid for double patenting;

IT IS ORDERED that defendants' motion (D.I. 287) is granted with respect to claims 10 and 12 of the '185 patent and claims 25, 26 and 30 of the '100 patent and denied with respect to the '865 patent for the reasons that follow:

1. On July 25, 2002, plaintiff Syngenta Seeds, Inc., filed a complaint against the defendants alleging infringement of three patents. The patents-in-suit descend from Application No. 07/951,715 ("the '715 application"). (D.I. 288 at 4) Ciba is

the original assignee of the '715 patent application. (Id. at 4) On May 10, 1995, Ciba filed Application No. 08/438,666 ("the '666 application"). (Id. at 5) On June 2, 1995, Ciba filed Application No. 08/459,504 ("the '504 application") as a divisional of the '715 application.

2. In 1996 Ciba merged with the Novartis family of companies, which included Novartis Corporation and Novartis Finance Corporation ("Novartis Finance"). (Id. at 3) Initially, the '715, '666 and '504 applications were assigned to Novartis Corporation. (Id. at 4) However, on May 29, 2002, Novartis Corporation assigned these applications, and patents that descended from these applications, to Novartis Finance. (Id. at 4)

3. On April 29, 1997, the '715 application issued as U.S. Patent No. 5,625,136 ("the '136 patent"), a patent which is not the subject of this litigation. (Id. at 6) In 2000 the Novartis family of companies merged with plaintiff. (Id. at 4)

4. On June 13, 2000, the '504 application issued as U.S. Patent No. 6,075,185 ("the '185 patent"). (Id. at 5) The specification of the '185 patent is identical to that of the '136 patent. (Id. at 6) On July 2, 1999, several months before the '185 patent issued, Novartis Finance submitted a terminal disclaimer over the '136 patent, even though Novartis Corporation had not yet assigned the '504 application to Novartis Finance.

(Id. at 4, 6)

5. On April 11, 2000, Application No. 09/547,422 ("the '422 application") was filed as a continuation of the '504 application. (Id. at 7) On November 29, 2001, the '422 application issued as U.S. Patent No. 6,320,100 ("the '100 patent"). (Id. at 7) The specification for the '100 patent is identical to that of the '136 and '185 patents. (Id. at 7) On March 21, 2001, several months before the '100 patent issued, Novartis Finance once again submitted a terminal disclaimer limiting the duration of the subsequent '100 patent to the terms of the '136 and the '185 patents. (Id.) This terminal disclaimer also predated Novartis Corporation's assignment of the '422 application's rights. (Id.)

6. On June 11, 2002, the '666 application issued as U.S. Patent No. 6,403,865 ("the '865 patent"). (Id. at 5) The '865 patent incorporates by reference the specification from the '136, '185, and '100 patents. (Id. at 8) Neither plaintiff nor the Novartis family of companies filed a terminal disclaimer for the '865 patent prior to the present litigation. (Id.) However, on August 17, 2004, plaintiff did file terminal disclaimers limiting the term of the '865 patent to the terms of the '136, '185, and '100 patents. (D.I. 327 at 4)

7. A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and

admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. See Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." Horowitz v. Fed. Kemper Life Assurance Co., 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" Matsushita, 475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." Pa. Coal Ass'n v. Babbitt, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249

(1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986).

8. The bar against obviousness-type double patenting prevents claims of subject matter different, but not patentably distinct, from the subject matter claimed in a commonly owned earlier patent. Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 967 (Fed. Cir. 2001). The purpose of the bar against double patenting is to prevent extension of the statutory patent monopoly beyond its specified term. Id. However, the owner or assignee of a patent or patent application can overcome the obviousness-type double patenting bar by filing a terminal disclaimer, which disclaims a portion of the term of the patent. Ortho Pharm. Corp. v. Smith, 959 F.2d 936, 940 (Fed. Cir. 1992). By statute a terminal disclaimer can be filed after the patent has been issued. 35 U.S.C. § 253 (2004) ("any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted."). Terminal disclaimers can also be filed during the course of litigation alleging the invalidity and/or unenforceability of the patent. Bayer AG v. Barr Labs., Inc., 798 F. Supp. 196, 197-98 (S.D.N.Y. 1992) (granting summary

judgment to patent owner and upholding validity of patent where terminal disclaimer had been filed post-complaint); Bott v. Four Star Corp., 675 F. Supp. 1069, 1074 (E.D. Mich. 1987)

(determining that terminal disclaimer filed in response to alleged infringer's double patenting summary judgment motion was permissible and did not "injure" alleged infringer), aff'd, 856 F.2d 202 (Fed. Cir. 1988) (unpublished decision); Technicon Instruments Corp. v. Coleman Instruments, Inc., 255 F. Supp. 630, 637, 642 (N.D. Ill. 1966) (upholding validity of patent for which terminal disclaimer was filed after trial began).

9. The '865 patent is not invalid for obviousness-type double patenting because of plaintiff's August 17, 2004 terminal disclaimers limiting the '865 patent to the terms of the '136, '185, and '100 patents. The statutory provision which establishes terminal disclaimers places no time limitation on filing these disclaimers. 35 U.S.C. § 253 (2004). In addition, several federal courts have allowed parties to file terminal disclaimers during the course of litigation alleging the invalidity of the patent. These rulings make sense given the underlying purpose of the bar against obviousness-type double patenting, namely to prevent extension of the statutory patent monopoly beyond its specified term. This purpose has been achieved by plaintiff's August 17, 2004 terminal disclaimers.

10. However, the '185 and the '100 patents are invalid

for obviousness-type double patenting. According to 35 U.S.C. § 253, only the owner of the patent may file a terminal disclaimer. Novartis Finance filed the terminal disclaimers for the '185 and '100 patents at a time when it neither owned those patents or the underlying applications. (D.I. 288 at 4, 7) Consequently, Novartis Finance did not have the authority to issue the terminal disclaimers, and these disclaimers are invalid. Plaintiff does not contest that the '185 and '100 patents are invalid for obviousness-type double patenting in the absence of a terminal disclaimer. (D.I. 327 at 5-6) Because plaintiff's terminal disclaimers for these two patents are invalid, the court finds that the relevant claims of these patents are invalid for double patenting under 35 U.S.C. § 253. As a result, claims 10 and 12 of the '185 patent and claims 25, 26 and 30 of the '100 patent are invalid, unless plaintiff, prior to trial, files new terminal disclaimers limiting: (1) the '185 patent to the term of the '136 patent; and (2) the '100 patent to the terms of the '185 and '136 patents.

Sue L. Robinson  
United States District Judge